

**d.) Remarks**

The applicant and her attorney would like to thank the Examiner for her interview conducted by telephone on or about July 13, 2005.

We wish to inform the Examiner that the inclusion of double quotes, as in the word magnet"s as noted by the examiner, is caused by processing by the programs furnished by the USPTO, which converts the text into the form submitted electronically to the USPTO. The word " magnet's " was submitted to these programs properly punctuated, but was transformed to the version " magnet"s " as it appears in the application available to the Examiner. Correction of this type of error in the converted program leads to yet other errors and so was not attempted. This bug was corrected in the present version of the USPTO software.

All of the Examiner's objections to the Specification have been addressed except for the last item, paragraph 5, where the Examiner refers to the "numerous instances of improper comma use." The Applicant's attorney and paralegal have both carefully proofed this application, and have unable to find such errors in use except for the specification paragraphs and claims amended herein. In addition, the Specification has been subjected to analysis by Microsoft Word's grammar checker with

similar results. The Examiner is invited to submit examples of such improper use and we will be happy to amend the application as required.

New claims 16-23 have been included in the present amendment. Claim 16 is similar to claim 1 but includes the further limitation that the upper and lower frames are physically independent from each other. The remaining claims track the independent claims of the last amendment exactly.

As stated at the time of the last telephone interview, *Mori* does not disclose a lower magnetic base which comprises a "\*\* \* \* punch die corresponding to each punch rod", in accordance with claim 1 of the current application. Furthermore, *Mori* will not permit punching anywhere on the page, in contrast to the present invention, as stated in claim 1. For that reason alone it is believed that the rejections of the claims remaining after the last amendment were improper.

It is further believed that the combination of the teachings of *Abe* and *Mori* are not legitimately combinable to form a rejection under section 103(a) for the reasons that follow.

#### **Prior Art Not Analogous**

*Abe* is not analogous prior art because it is neither in the field of endeavor of the present invention nor is it reasonably

pertinent to the specific problem with which the present invention is involved. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986). The inventor is presumed to have full knowledge of prior art in his field of endeavor, but with regard to prior art outside of that field the inventor is only presumed to have knowledge from those arts that are reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174 (Fed. Cir. 1993).

*Abe* teaches a means for strengthening the power of the magnetic attraction of a magnetic sheet having a certain but weak magnetic attraction. *Abe* 1/21 et seq. The present invention relates to a device for punching holes in a sheet, such as paper, anywhere over the entire extent of the sheet. Thus, *Abe* is not presumed to be known to the inventor because it is not in the field of endeavor of the inventor.

Furthermore, *Abe* is not analogous prior art because it is not reasonably pertinent to the problem that the inventor of the present invention was trying to solve.

"A reference is reasonably pertinent ... if it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem... [I]f an invention is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it."

*In re Clay*, 23 USPQ.2d 1058, 1061 (Fed. Cir. 1992). The present invention does involve magnets, but they could not be reasonably

called magnetic sheets. Even if they could be construed to be sheets, there is no indication in the present invention that the magnets require increasing their magnetic attraction. The fact that both the current invention and Abe contain magnets is simply not enough to make them analogous art." which teaches the present invention."

**C. The Reference Does Not Suggest the Combination of Elements**

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination. In *re Greiger*, 2 USPQ.2d 1276, 1278 (Fed. Cir. 1987). When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why this combination of reference teachings is proper. Absent such reasons or incentives, the teachings are not combinable. *Ex parte Skinner*, 2 USPQ.2d 1788, 1790 (BPAI 1987). Abe does not teach the use of magnetic members in aligning the punch rod and the punch die of a paper punch, nor the alignment of any other magnetic members for any purpose.

Furthermore, *Mori* does not teach the use of magnetic structures for aligning the punch rod and punch die either. In fact, the magnetic base 38 of *Mori* appears only in the jig of *Mori*, Fig 12, and not in the punch mechanism itself. Although

the disclosure of *Mori* is far from pellucid, it appears the purpose of magnetic base 38 is simply to hold the cover 30a of the jig to the base 32 of the jig when the jig is closed, as shown in *Mori*, Figure 17. Thus, although element 38 of *Mori* is called a magnetic base in the *Mori* patent, it bears no relation to the magnetic base in the present invention, which has the function of aligning with the corresponding magnetic base above the paper, and wherein both the upper and lower bases of the present invention have the further function of guiding the punch rod through the sheet being perforated. Thus, when "magnetic base" is used in the claims of the present invention it is used to mean the structure disclosed in this application through repeated descriptions in the disclosure, as well as in the drawings, which is in agreement with the claim construction doctrine that "an applicant can be her own lexicographer." *Markman v. Westview Instruments, Inc.* 52 F.3d 967, 976 (Fed. Cir. 1995), *aff'd* 116 S.Ct. 1384 (1996)) Thus, claims 1-4 et seq. are not obvious because the references do not contain the elements combined and do not teach or suggest the combination of elements cited by the Examiner.

#### A. Prior Art Not Analogous

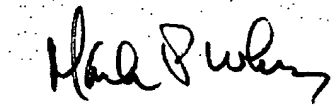
Not only is *Abe* not analogous prior art for the purposes of claims 1-4 and 9-17, but neither is *Mori*, because neither is

reasonably pertinent to the problem with which the inventor was involved. *In re Deminski*, 230 USPQ 313, 315. *Mori* teaches a punch which can punch along the edges of a sheet. But the entire reason for the present invention, with its magnetic bases on either side of the paper, and physically unattached to each other, is to allow the punch to make holes anywhere on the surface of the paper. Because *Mori* was not involved with this problem, it cannot be combined with another invention under section 103(a) as a basis for rejecting claims 1 et seq..

For the foregoing reasons, the Applicant submits that the Magnetically Aligned Hole punch as disclosed and claimed in the present application is not fairly taught by any of the references of record, either taken alone or in combination. Therefore, allowance of the present application is in order, and is requested.

The Commissioner is hereby authorized to charge any additional fees due to my deposit account 231706.

Yours truly,

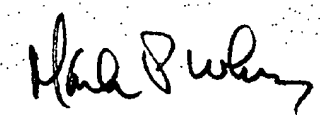


Mark P. White  
MPW/ag

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A handwritten signature in black ink, appearing to read "Mark P. White", with a stylized flourish at the end.

Mark P. White  
Reg. No. 37,757

(b)Amendment to Drawings

The drawing sheet containing Figs. 7 and 7B should be removed from this application, as they are duplicates of Figs. 3 and 3b, and are not mentioned anywhere in the application as Figs. 7 or 7b.

References to the sharpened end of the punch have been deleted, as they are not referred to anywhere else in the Specification, and have no relevance to the current application. Accordingly, no amendments to Figure 1 have been included.